

U.S. Application No. 09/816,152

Attorney Docket No.: 144009.00100

**d.) Remarks.**

Applicant has amended claims 1, 8, 9, 11, 18-20, 23, 25-28, 30, 31, 37, 40, 41, 46, 51-53, 55, 56 and 58-59, all to more clearly define the invention. Support for the amendments is found throughout the specification and also in the claims. No new matter or new issues are presented with these amendments. Accordingly, claims 1-59 are currently pending.

**Remarks Regarding Figure 8**

Enclosed please find a formal copy of Figure 8. Applicant respectfully requests that this figure be included with the specification. No new matter is added with this figure, support for which can be found throughout the specification, such as, for example, at least at pages 9 and 20, and also in the claims.

**Remarks Regarding Oath/Declaration**

The Declaration submitted with the application is considered defective because it does not identify the citizenship of each inventor. A substitute Declaration is enclosed which identifies the citizenship of the inventors.

**Remarks Regarding 37 C.F.R. § 1.75(c)**

Claim 37 is objected to, under 37 C.F.R. § 1.75(c), for allegedly being in improper dependent form for not limiting the subject matter of a previous claim. Applicant respectfully traverses this objection.

In an effort to expedite prosecution, applicant has amended claim 37 and this objection is believed to be moot.

**Remarks Regarding 35 U.S.C. § 112, Second Paragraph**

Claims 9, 11 and 41-45 stand rejected, under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Applicant respectfully traverses this rejection.

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Applicant has amended claims 9, 11 and 41 and this rejection is moot.

**Remarks Regarding 35 U.S.C. § 101**

Claim 40 stands rejected, under 35 U.S.C. § 101, as allegedly directed toward non-statutory subject matter. Applicant respectfully traverses this rejection.

In an effort to expedite prosecution, application has amended claim 40 to clarify that the claimed invention is directed to a business model for "operating and maintaining" the data base and thus this rejection is moot.

**Remarks Regarding 35 U.S.C. § 102(e)**

A. Claims 1-11, 17, 30, 31, 34-47, 51-55 and 57-59 stand rejected, under 35 U.S.C. § 102(e), as allegedly anticipated by Segal et al. (U.S. Patent Application Publication No. 2001 10041991; "Segal"). Applicant respectfully traverses this rejection.

Enclosed is a Rule 131 Declaration in which the inventors state that their claimed invention (which is referred to as "Patient Direct Systems" in the 27 page attachment) was conceived and reduced to practice prior to the filing date of the provisional application which became Segal. Accordingly, this rejection is overcome.

**Remarks Regarding 35 U.S.C. § 103(b)**

A. Claim 12 stands rejected, under 35 U.S.C. § 103(b), as allegedly obvious over Segal in view of Baker (PCASSO). Applicant respectfully traverses this rejection. In view of the 131 Declaration provided with respect to Segal, Segal is no longer prior art to the claimed invention and, thus, this rejection is overcome.

B. Claims 13-15, 20-22, 25-29, 32, 33 and 48-50 stand rejected, under 35 U.S.C. § 103(b), as allegedly obvious over Segal in view of Malik (U.S. Patent Application Publication No. 2001 0037219). Applicant respectfully traverses this rejection. In view of the 131 Declaration provided with respect to Segal, neither Segal or Malik is prior art to the claimed invention and, thus, this rejection is overcome.

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C. Claim 16 stands rejected, under 35 U.S.C. § 103(b), as allegedly obvious over Segal in view of Shear (U.S. Patent No. 4,827,508). Applicant respectfully traverses this rejection. In view of the 131 Declaration provided with respect to Segal, Segal is no longer prior art to the claimed invention and, thus, this rejection is overcome.

D. Claims 18 and 19 stand rejected, under 35 U.S.C. § 103(b), as allegedly obvious over Segal in view of Ertel (U.S. Patent No. 5,307,262). Applicant respectfully traverses this rejection. In view of the 131 Declaration provided with respect to Segal, Segal is no longer prior art to the claimed invention and, thus, this rejection is overcome.

E. Claims 23 and 24 stand rejected, under 35 U.S.C. § 103(b), as allegedly obvious over Segal in view of Malik, and further in view of Ertel. Applicant respectfully traverses this rejection. In view of the 131 Declaration provided with respect to Segal, neither Segal or Malik is prior art to the claimed invention and, thus, this rejection is overcome.

F. Claim 56 stands rejected, under 35 U.S.C. § 103(b), as allegedly obvious over Segal in view of Joao (U.S. Patent No. 6,283,761). Applicant respectfully traverses this rejection. In view of the 131 Declaration provided with respect to Segal, Segal is not prior art to the claimed invention and, thus, this rejection is overcome.

#### **Additional Remarks Regarding Office Action**

Applicant reviewed the Office Action, and specifically the statements regarding the cited references. In an effort to expedite prosecution, applicant provides the following remarks with respect to comments made in the Office Action in relation to the cited references. For the convenience of the Examiner, applicant herein maintains the paragraph numbering system utilized in the Office Action.

With respect to paragraph 8(A), it is alleged, in part, that: at paragraph 13 of Segal, *"the Examiner interprets 'physicians offices and facilities such as hospitals' to be a form of 'sources'."* Applicant has reviewed paragraph 13 and respectfully disagrees. At paragraph 13, which is in the background section, Segal is referring to the problem that "patients have no ownership or control with which to consolidate the records" and

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"without a personal stake, physicians rarely take the initiative to gather and integrate all records from a variety of physicians offices...." Stating a problem absent a solution or even a potential solution is not a disclosure or suggestion of applicant's claimed invention.

With respect to paragraph 8(H) {and also 11(E)}, it is alleged that Segal discloses that *"wherein one or more medical record possesses the characteristic of non-repudiation (para. 8 and para. 131 of Segal)." Applicant has reviewed both paragraphs and respectfully disagrees. Segal paragraph 8 is simply a definition of a medical records. This may be a typographical error in the Office Action. Segal paragraph 131 refers to a process of quality assurance of images. This does not disclose or suggest non-repudiation according to applicant's claimed invention, which is described in the specification:*

*"Medical records that are verified as accurate attain the aspect of non-repudiation (i.e. that the accuracy and correctness of the information is as good or better than exists at the source sites from which the records were obtained), and may for all purposes be relied upon. As such, non-repudiated records may therefore be primary for future treatment or diagnoses. This aspect of non-repudiation is believed to be unavailable from any other medical information system. This allows the system provider to guarantee or warranty that the information can be relied upon with regard to future treatments" (see, specification, page 17, lines 11-20.*

With respect to paragraph 8(I) {and also 8GG)}, it is alleged that Segal discloses that *"wherein said non-repudiated medical record is primary for treatment of the patient ... (para. 5 of Segal)." Applicant has reviewed paragraph 5 and respectfully disagrees. Segal paragraph 5, which is in the background section, simply states that a "focused medical record is the cornerstone of comprehensive health care." This does not disclose or suggest primary records according to applicant's claimed invention. Applicant further respectfully notes that there is no discussion whatever of non-repudiation in Segal.*

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With respect to paragraph 8(J) {and also 11(C) and 11(D)}, it is alleged that Segal discloses that *"wherein each medical record is certified as accurate (para. 8 of Segal)."* Applicant has reviewed paragraph 8 and respectfully disagrees. Segal paragraph 8, which is in the background section, is simply a definition of a medical records. This may be a typographical error in the Office Action.

With respect to paragraph 8(K) {and also 8(V), 8(X), 8(FF)}, it is alleged that Segal discloses that *"wherein each medical record is certified as accurate by the patient, by the source from which the medical record was obtained, by a system provider or by a combination thereof (para. 131 of Segal)."* Applicant has reviewed paragraph 131 and respectfully disagrees. Segal paragraph 131 refers to a process of quality assurance of images. This does not disclose or suggest certification according to applicant's claimed invention, which is more fully discussed in the instant specification at pages 15-17.

With respect to paragraph 8(II) {and also 13(A), 14(A)}, it is alleged that Segal discloses that *"vetting means, wherein said vetting means allows said subjects to supplement said medical records with information relating to accuracy of said medical records (para. 6 and para. 25 of Segal)."* Applicant has reviewed paragraphs 6 and 25 and respectfully disagrees. Segal paragraph 6, which is in the background section, refers to what might be found in a typical medical record (again this may be a typographical error in the Office Action). Paragraph 25 refers to *"the patient having the option of giving a doctor access to view and update the information"* This does not disclose or suggest vetting according to applicant's claimed invention, which is more fully discussed in the instant specification at pages 17-20. In particular, applicant wishes to note that it is prevailing practice in the health care field in the United States for a provider who wishes to correct a medical record not to delete or obscure any entry in the medical record, but rather to do nothing or to correct or supplement the medical record through annotations to, or comments about, entries made earlier.

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### Remarks Regarding Interview and Terminal Disclaimer

The undersigned appreciates the opportunity to meet with Examiner Najarian and Supervisor Thomas on Tuesday, June 28, 2005. At that meeting, the invention was generally discussed as were the claims, and the Segal reference. The undersigned stated that the inventors would review Segal, and will likely file a Rule 131 Declaration swearing behind the filing date of the provisional from which Segal claims priority.

In addition, Supervisor Thomas noted that the PTO would issue an obviousness-type, double-patenting rejection in view of U.S. Application No. 09/822,261, which claims priority to the instant application. For this reason, enclosed is an appropriate Terminal Disclaimer executed by the undersigned.

### Conclusion

The application including pending claims 1-59, are believed to be in condition for allowance and the prompt issuance of a Notice of Allowance is respectfully requested.

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No fees are believed to be due with the filing of this Amendment. However, if any fees are later determined to be due, including any fees for an extension of time, applicant respectfully requests that extension and that all such fees be charged to **Deposit Account No. 50-1682, referencing Attorney Docket No. 144009.00100.**

Respectfully submitted  
**POWELL GOLDSTEIN LLP.**

Date: July 7, 2005

By:

~~James R. Remick~~  
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Enclosed: Substitute Declaration  
Rule 131 Declaration  
Figure 8  
Terminal Disclaimer

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